

**REMARKS**

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Claims 1 through 13 remain pending in this application. Claim 14 has been added. Claim 1 has been amended. Support for the amendments to claim 1 for the inclusion of personalized indicia is found throughout the specification and for the concealed message at page 5, line 5. Support for new claim 14, is found at page 3, line 21 and other portions of the specification.

Claims 1-8 and 13 have been rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Stich et al. (US 5,760,381). Reconsideration and withdraw of the rejection is earnestly solicited.

The standard of review under 35 USC 102(b) is well founded and in this regard see, Kalman v. Kimberly-Clark Corp., 713 F. 2d 760, at 771, 218 USPQ 781, at 789 (1983), where the Court of Appeals for the Federal Circuit held:

“A party asserting that a patent claim is anticipated under 35 USC 102 must demonstrate, among other things, identity of invention. In cases like this, identity of invention is a question of fact...(citation omitted) and one who seeks such a finding must show that each element of the claim in issue is found, either expressly described or under the principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice.”

“A claim is anticipated if each and every element as set forth in the claim is found, either expressly or inherently described, in a single, prior art reference.” Verdegaal Bros. V. Union Oil Co., of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

“The identical invention must be shown in as complete detail as is contained in the ...claim.” Richardson v. Suzuki Motor, Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Stich et al. relate to a point of sale card package which is provided in retail outlets and carries a card to be activated at the point of sale. The package is not a greeting card as required by each of claims 1-8 and 13 of the present invention and instead Stich et al. relate to a non-descript package having only information relating to the use of the card or advertising pertaining to the manufacturer of the card or presenter or carrier of the service. Greeting cards are created for specific events, such as birthdays, holidays, anniversaries, graduations and the like and are intended to provide the presenter with a more pleasing or appropriate packaging, announcement or statement under which the card is given.

Stich et al. represent exactly the type of package over which the present invention is an improvement over. That is the provision of a greeting card that can be personalized to create a gift giving vehicle that is significantly more aesthetically appealing to the recipient than one which provides a generic offering or undertaking. Thus, Stich et al. do not anticipate claims 1-8 and 13 of the present invention as there is no disclosure in Stich et al with respect to the use of a greeting card.

In addition, Stich et al. do not disclose a gift card and greeting card assembly that contains both personalized and preprinted indicia, nor the feature that the gift card conceals a message as required by claim 1, as amended. As such, Stich et al. do not disclose or anticipate claim 1.

Claims 9-11 have been rejected by the Examiner under 35 U.S.C. 103(a) as obvious over Stich et al. Reconsideration and withdraw of the rejection is earnestly solicited.

In order to establish *prima facie* obviousness, three basic elements must be met: there must be (a) some suggestion or motivation to combine the references or modify the reference teaching; (b) a reasonable expectation of success; and (c) the reference or references when combined must teach or suggest each claim limitation. In addition, in order to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180, USPQ 580 (CCPA 1974) (M.P.E.P. 2143.03). The mere fact that knowledge *may* have been within the skill of an ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *Smiths Industries Medical Systems Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999).

As discussed previously, Stich et al. do not disclose or teach the use of a greeting card as a delivery vehicle for a gift card and rather Stich et al. teaches only the use of a generic vehicle for a point of sale phone card. One with skill in the art would not draw on generic packages, such as a box, in order to provide a personalized, sentimental gift to a recipient.

As such, claims 9-11 are not obvious in view of Stich et al. as Stich et al. do not teach or suggest the provision of a greeting card to deliver a gift card to a recipient.

Claim 12 has been rejected by the Examiner under 35 U.S.C. 103(a) as unpatentable over Stich et al in view of Smith et al (US 5,777,305). Reconsideration and withdraw of the rejection is earnestly solicited.

The standard of review is clearly set forth in the preceding section and is not repeated here for sake of brevity.

Smith et al. do not remedy the deficiencies of Stich et al. in that Smith et al. teaches the use of a generic package like Stich et al to deliver a point of sale phone card to the purchaser. The question of whether the requisite suggestion or motivation is present cannot be resolved on the basis of subjective belief, unknown authority, or general conclusions about what is "basic knowledge" or "common sense." *In re Lee*, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002). Rather, a decision as to whether multiple references can be combined "must be based on objective evidence of record." *Id.* While such references may be generally combinable for the purposes of making a suggestion relating to generic point of sale packages, there is no teaching or suggesting relating to the use of a greeting card and gift card combination and as such, the combination does not render the present invention unpatentable.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited. The Examiner is encouraged to contact the undersigned in the event any small matters remaining outstanding so as to eliminate the necessity of another action and response.

No fees are believed due in connection with this Amendment and response.

Respectfully submitted,



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**CERTIFICATE OF MAILING**

Sir:

I hereby certify that this ASSOCIATE POWER OF ATTORNEY and AMENDMENT is being deposited with the United States Postal Service, first class mail addressed to the Commissioner for Patents, Mail Stop Non-fee Amendment, P.O. Box 1450, Alexandria, VA 22313-1450 on October 20, 2003

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